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10/560,256	03/08/2007	Masaki Hirose	450106-05228	5011
7590 William S Frommer Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151				
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EXAMINER				
DAZENSKI, MARC A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,256

Applicant(s)

HIROSE ET AL.

Examiner

MARC DAZENSKI

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1 and 9-11 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

... a signal does not fall within one of the four statutory classes of Sec. 101.

... signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of Sec. 101.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 10 is drawn to functional descriptive material recorded on a computer-readable medium. Normally, the claim would be statutory. However, the specification, at page 106 defines the claimed

computer readable medium as encompassing statutory media such as a "ROM", "hard drive", "optical drive", etc, as well as **non-statutory** subject matter such as "...a program that composes the software is installed from a network..." (wherein if the software is installed from a network then the examiner maintains that this is merely a signal transmitted over some sort of undisclosed communication means and is therefore non-statutory).

A "signal" embodying functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory classes of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over David et al (US PgPub 2002/0131764), hereinafter referred to as David, in view of Um et al (US Patent 7,536,087), hereinafter referred to as Um.

Regarding **claim 1**, David discloses identifying, recording, and reproducing information. Further, David discloses a video, audio, and/or data signal processing system comprising a recorder for recording video and/or audio and/or data material on a recording medium, which reads on the claimed, "an information process apparatus that

manages data recorded on a record medium," as disclosed at paragraph [0010]; the apparatus comprising:

a second generator for generating second, universally unique, identifiers for pieces of material, the second identifiers being generated in respect of one or more of the first identifiers, which reads on the claimed, "first generation means for generating management information...that associates a first identifier that can identify the data in any area with information about the data," as disclosed at paragraph [0010];

a first generator for generating first material identifiers for identifying respective pieces of material on the medium such that each piece is differentiated from other pieces on the medium, the first identifiers need not be universally unique and can thus be smaller than the universally unique identifiers (i.e., the second identifiers), as well as every tape edit event generates a new MURN, which reads on the claimed, "second generation means for generating a second identifier that can identify the data in a storage area of the record medium when the data is updated, the data amount of the second identifier being smaller than that of the first identifier," as disclosed at paragraphs [0010]-[0012] and [0115];

camcorder (500) which records video and audio material on a recording medium along with metadata, the metadata being linked to the material by UMID's (i.e., the first identifier) and MURNs (i.e., the second identifier), the MURNs being generated as the material is recorded on the tape and preferably being recorded in the user bits of tape time codes, which reads on the claimed, "addition means for adding the second identifier generated by the second generation means to the management information to

associate the second identifier with the information about the data; and record means for recording the management information to which the second identifier has been added by the addition means on the record medium," as disclosed at paragraphs [0090]-[0094].

However, David fails to disclose that the first generation means generates management information "during a record medium format process." The examiner maintains that it was well known in the art to record management information during a record medium format process, as taught by Um.

In a similar field of endeavor, Um discloses a method of managing recorded still pictures on a recording medium. Further, Um discloses formatter 17 which records management information regarding MPEG2 video onto a rewritable recording disk, which reads on the claimed, "...during a record medium format process...", as disclosed at column 4, lines 5-18 and 40-44.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of David to include the teachings of Um, for the purpose of making more efficient use of the available free-space on a storage medium.

Regarding **claim 2**, the combination of David and Um discloses everything claimed as applied above (see claim 1). Further, David discloses camcorder (500) recording video and audio data on a recording medium as well as metadata may be recorded on the tape, which reads on the claimed, "wherein the data contain at least

one of video data, audio data, and meta data added to the video data,” as disclosed at paragraph [0090].

Regarding **claim 3**, the combination of David and Um discloses everything claimed as applied above (see claim 1). Further, David discloses that the UMID links the material data to the metadata and that it comprises a universally unique identifier, which reads on the claimed, “wherein the information about the data contains information about a directory path name and a file name of the data,” as disclosed at paragraph [0091].

Regarding **claim 4**, the combination of David and Um discloses everything claimed as applied above (see claim 1). Further, David discloses UMIDs having 23, 32, or 64 bytes and MURNs being written in the 80 time code user bits, which reads on the claimed, “wherein the first identifier is composed of 64 bytes and the second identifier is composed of 20 bits,” as disclosed at paragraphs [0091], [0251], and [0284].

Regarding **claim 5**, the combination of David and Um discloses everything claimed as applied above (see claim 1). Further, David discloses the MURNs comprising a Tape ID as well as a number that increments, decrements, or otherwise varies from material to material on the tape, which reads on the claimed, “wherein the second identifier is composed of a first portion that represents the type of the data and a second portion that represents a serial number of the second identifier,” as disclosed at paragraphs [0095] and [0286].

Regarding **claim 6**, the combination of David and Um discloses everything claimed as applied above (see claim 5). Further, David discloses that when a new

MURN needs to be generated the MURN generator interrogates the telefile to find the highest previously used MURN value, increments it and uses that as the new MUR value, writing the new MURN value back to the telefile, which reads on the claimed, "search means for searching a plurality of second identifiers recorded on the record medium for the maximum value of the second portion, wherein the second generation means generates the second identifier according to the maximum value for which the search means has searched so that the second identifier does not become redundant to the plurality of second identifiers recorded on the record medium," as disclosed at paragraph [0290].

Regarding **claim 7**, the combination of David and Um discloses everything claimed as applied above (See claim 1). Further, David discloses an ingestion processor (178) which therefore represents a data processor which can access any of the video tape recorders (204) in order to reproduce the audio/video material from the video tapes loaded into the video tape recorders, which reads on the claimed, "reproduction means for reading the data from the record medium and reproducing the data," as disclosed at paragraph [0234].

Regarding **claim 8**, the combination of David and Um discloses everything claimed as applied above (see claim 7). Further, David discloses editing terminal (184) communicating a request for material data, reading the UMIDs identifying the audio/video material and then in response to this request the ingestion processor (178) selectively reproduces these material items that are identified by the UMIDs from the recording medium, which reads on the claimed, "read means for reading the

management information read by the record means; and hold means for holding the management information read by the read means, wherein the reproduction means reads the data to be reproduced from the record medium according to the management information read by the read means and held by the hold means and reproduces the data," as disclosed at paragraph [0237].

Regarding **claim 9**, the examiner maintains that the claim is the corresponding method to the apparatus of claim 1, and therefore the limitations of the claim are rejected in view of the explanation set forth in claim 1 above.

Regarding **claim 10**, David discloses that the methods described herein may be embodied and represented as instructions of a computer program, as disclosed at paragraph [0315]; further, the examiner maintains that the claim is simply the corresponding program implementing the method of claim 9, and therefore the limitations of the claim are rejected in view of the explanation set forth in claim 9 above in addition to the disclosed paragraph [0315].

Regarding **claim 11**, the limitations of the claim are rejected in view of the explanation set forth in claim 9 above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC DAZENSKI whose telephone number is (571)270-5577. The examiner can normally be reached on M-F, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621

/MARC DAZENSKI/
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